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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/439,427

Filing Date: November 15, 1999

Appellant(s): APPS ET AL.

John E. Carlson (37794)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/01/09 appealing from the Office action
mailed 09/30/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2002-1675 as stated in the Appellant's brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,868,080	WYLER et al	02-1999
5,197,395	PIGOTT et al	03-1993
4,522,009	FINGERSON	06/1985
2,599,076	STURGIS	06-1952

"The Random House College Dictionary" , revised edition, 1980, page 1184

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 36 stands rejected under 35 U.S.C. 102(b) as being anticipated by Wyler et al. The patent to Wyler et al teaches structure as claimed including a pallet (10) having at least one deck member (either one of Wyler's reinforcing bars 32 or Wyler's deck 14 and reinforcing bars 32 taken together), the pallet prepared by a method comprising: providing the at least one deck member having a first surface and a second surface (Wyler's reinforcing bar 32 has a top surface 34 and a bottom surface) and mechanically scuffing at least one of the first and second surfaces! of the deck member to define a slip-resistant surface thereon (Wyler's top surface 34 of reinforcing bar 32 is an anti-skid surface 36 formed by roughening or knurling). The only possible distinction

between Wyler and claim 36 is the limitation that at least one of the first and second surfaces of the deck member is mechanically scuffed: to define a slip-resistant surface thereon. This limitation is not restricted to mechanically scuffing either the entire upper or lower surface of the deck member (e.g., Wyler's upper surface 20 of deck 14). Instead, this limitation requires only that any surface of a deck member of a pallet be mechanically scuffed to define a slip- resistant surface thereon. Since Wyler's top surface 34 of reinforcing bar 32 of pallet 10 is roughened or knurled to form an anti-skid surface 36. The method of making limitations do not affect the product itself (i.e., the claimed pallet)and therefore cannot impact patentability to the product. The claims include product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. It is noted that "scuff" is defined as "to be or become marred or scratched" ("The Random House College Dictionary). (It is noted here that the answer provides a copy of the dictionary meaning cited on the attached-892, such dictionary meaning having been used previous in the actions of record.) The surface of Wyler is defined as knurled or roughened, such provides a marred, scratched and scuffed surface. The patent to Wyler teaches structure as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22, 23, 26, 29-31, 34-37, 39-55 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pigott et al ('395) in view of Wyler et al and Fingerson. The patent to Pigott teaches a plastic pallet (fig. 1) having upper and lower decks (12) and a plurality of supports (14) therebetween. The upper and lower decks are separately molded and are attached to each other via the supports. Spaces between the supports define fork-receiving regions. For claims 22, 23, 26, 29-31, 34 and 35-37, Pigott fails to teach that the top surface of the upper deck, the bottom surface of the upper deck (in the fork-receiving regions), and the bottom surface of the lower deck are scuffed to create slip-resistant surfaces. First, Wyler teaches the benefits of having slip-resistant/anti-skid surfaces on the top surface of the upper deck (to inhibit movement of the payload disposed on the pallet; see column 1, lines 64-67), on the bottom surface of

the upper deck (to prevent slippage of the pallet when it is being moved; see column 2, lines 45-47), and on the bottom surface of the lower deck (to ensure non-slip contact with a floor or racking structure; see column 2, lines 26-28). Second, Fingerson teaches the concept of roughening/scuffing a surface in order to make it into an anti-skid surface (see column 6, lines 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pallet of Pigott by roughening/scuffing the top surface of the upper deck, the bottom surface of the upper deck, and the bottom surface of the lower deck thereof, because of the advantages taught by Wyler. Furthermore, scuffing the pallet surfaces, such as is taught by Fingerson, is an easy and non-expensive way to provide anti-skid surfaces on the pallet of Pigott. The method of making limitations do not affect the product itself (i.e., the claimed pallet) and therefore cannot impact patentability to the product. The claims include product-by-process claims. Even though product-by-process claims are limited by and defined by the Process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The provision of a dull, shiny, finished surface is a matter of desirability and choice since such would perform equally as well. It is noted that "scuff" is defined as "to be or become marred or scratched" ("The Random House College Dictionary). The surface of Wyler and Fingerson is defined as knurled or roughened, such provides a marred, scratched and scuffed surface.

Claims 24, 25, 27, 28, 32, 33 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pigott et al (5,197,395) in view of Wyler et al and Fingerson as applied to claims 22, 23, 26, 29-31, 34 and 35-37 above, and further taken with or without of Sturgis. As stated above, Pigott in view of Wyler and Fingerson teaches the specifications of claims 22, 26, 31 and 36 above, including a pallet with various scuffed surfaces. For claims 24, 25, 27, 28, 32, 33 and 38, Pigott in view of Wyler and Fingerson fails to teach a means for scuffing the surfaces. The method of making limitations do not affect the product itself (i.e., the claimed pallet) and therefore cannot impact patentability to the product. The claims include product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. However, although such carries no weight in a utility claim, the patent to Sturgis teach a cup-shaped abrading brush with wire tufts (see Fig. 1). This type of brush would be more than capable of scuffing the plastic surfaces of a pallet, as desired/needed, and therefore, it would have been obvious to use such a brush to scuff the surfaces of the pallet of Pigott in view of Wyler and Fingerson. It is noted that “scuff” is defined as “to be or become marred or scratched” (“The Random House College Dictionary). The surface of Wyler and Fingerson is defined as knurled or roughened, such provides a marred, scratched and scuffed surface.

(10) Response to Argument

It is repeated, the applicant has provided an affidavit filed under 37 CFR 1.132. The declaration under 37 CFR 1.132 filed 01/03/05 is insufficient to overcome the rejection of the claims based upon 35 USC 102b rejection under the patent to Wyler et al as set forth in the last Office action because it fails to set forth facts that are germane to the rejection at issue, the showing is not commensurate in scope with the claims. Applicant in the declaration has made conclusions and assumptions that are based on opinion or an interpretation of the expressions "scuffed, knurled".

With regard to the remarks regarding claim 36, note the following. The appellant discusses that each limitation of a product-by-process cannot be ignored. Further, the appellant states "The Board of Appeals has already indicated that if the product made by the claimed process is different from the prior art product, the claim is not anticipated." The examiner agrees. If the product made by the claimed process is different from the prior art product then the claim is not anticipated. However, the product of Wyler is the same as the claimed matter. Appellant discusses how Wyler teaching of a surfaces roughened or knurled does not meet the limitation of a "scuffed" surface. Appellant further provides a declaration that the teaching of Wyler of a roughened or knurled surface is not the same as a scuffed surface. However, as stated in the rejection "scuff" is defined as to be or become marred or scratched, which is taught by the surface of Wyler being defined as roughened.

With regard to claims 39, 40, 41, 42, 43, 44, note the following. The above remarks regarding the expression "scuffed" applies here also. Further, the limitation

that the scuffing pattern includes a “multi-directional” scuffing pattern is met by a parallel line that extends in opposite directions. The references teach at least such limitation. It is further noted that the reference applied teach injection molding including a single material to form parts of the structure. The prior art taught by the references teaches the claimed **product made** as discussed above.

With respect to appellant’s remarks regarding claims 24, 25, 27, 28, 32, 33, 38 regarding the none of the references disclosed teaches the use of a wire brush, note the following. Sturgis teaches a brush to provide a roughened surface and further, the product made by the references applied teach the limitations as claimed. Further, to provide a roughened/scuffed surface using a brush is a well known practice, such as that used in the pouring of concrete and roughening the surface thereof to provide a less slippery surface. Knowing such knowledge and practice, such would have been a reasonably predictable result providing the same intended result.

In conclusion, it is noted that in the previous decision by the Board, the following was stated. The claims include product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In response to the Board Decision, appellant amended the claims to include “scuffs” as opposed to simply stating that the pallet

made by the product includes a creation of a slip-resistant scuffed texture and further provided a declaration as to the observed differences by Mr. Apps. Again, it is noted that the Board in previous decision stated that the claims are product by process type claims and discusses why the prior art meet the claimed invention. Additionally, It is noted that the rejection provides reasons why the declaration is insufficient. Further, it is a difference in interpretation of the language of the claims that appellant appears to argue. As shown above, the examiner as provided a clear definition of how such language is interpreted and such interpretation teaches all structure as claimed.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained again by the Board.

Respectfully submitted,

/José V. Chen/

Primary Examiner, Art Unit 3637

Conferees:

Lanna Mai /LM/

Darnell Jayne /dj/